

III. REMARKS

United States Serial No. 10/799,500 was filed on March 12, 2004. Claims 1-26 are currently pending. Claims 1 and 23 are amended by the present response, and new claim 27 has been added. In view of the amendments and remarks set forth herein, Applicants respectfully request reconsideration and allowance of claims 1-27.

35 U.S.C. §112, Second Paragraph

Claims 3, 8, and 23 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection of claims 3, 8, and 23.

Claim 3

With respect to claim 3, it is specifically alleged that the recitation "...impurities in the total amount of no more than about 3%" contradicts the recitation in claim 1 of the positive amount of impurities of "at least 0.05%." Applicants respectfully submit that claim 3 does not contradict claim 1. The impurity level of "at least 0.05%" recited in claim 1 is opened ended, which includes all impurity levels of 0.05% and greater. Claim 3, which claims an illustrative embodiment of the process for preparing a powdered poly 2-hydroxyethyl methacrylate, recites a total impurity level of no more than 3%. The recitation of "impurities in the total amount of no more than about 3%" includes a range of impurities of 0.05% to no more than about 3%. Applicants submit that one having ordinary skill in the art can easily ascertain that the impurity range of claim 3 is from about 0.05% to about 3%. Accordingly, Applicants respectfully submit that claim 3 is clear and therefore request that the rejection of claim 3 be withdrawn.

Claim 8

Applicants note that the Office Action does not articulate specific grounds for the rejection of claim 8. Applicants nevertheless assume that the basis for the rejection of claim 8 is similar to the rejection of claim 3, namely, that the recitation "...impurities in the total amount of no more than about 3%" contradicts the recitation in claim 2 of the positive amount of impurities in the range of "about at least 0.05% to about 0.1." Applicants respectfully submit that claim 8 does not contradict claim 2. Claim 8, which claims an illustrative embodiment of the process for preparing a powdered poly 2-hydroxyethyl methacrylate, recites a total impurity level of no greater than 3%. The recitation of "impurities in the total amount of no more than about 3%" includes a range of impurities of 0.05% to no more than about 3%. Applicants submit that one having ordinary skill in the art can easily ascertain that the hydroxyethyl methacrylate monomer used in the process of claim 8 may contain a total impurity level of 3%, about 0.05% to about 0.1% of which is ethylene glycol dimethacrylate impurity. Diethylene glycol monomethacrylate and methacrylic acid, if present, account for the remainder of impurity in the monomer. Accordingly, Applicants respectfully submit that claim 8 is clear and therefore request that the rejection of claim 8 be withdrawn.

Claim 23

Claim 23 depends from claim 16. It is specifically alleged that a cosmetic composition is claimed in claim 23, while claim 16 is directed to a process for preparing a pressure sensitive adhesive. Applicants have amended claim 23 to depend from claim 2. Accordingly, Applicants respectfully submit that claim 23 is clear and therefore request that the rejection of claim 23 be withdrawn.

35 U.S.C. §103(a)

Claims 1-4, 8, 9, and 13-15 have been rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 3,784,540 to Kliment in view of U.S. Patent No. 5,601,723 to Kita. It is specifically alleged that Kliment discloses a process for preparing a powdered poly 2-hydroxyethyl methacrylate in an organic solvent. The Office Action specifically concedes that Kliment does not disclose polymerization in water. However, it is alleged that Kita discloses an aqueous polymerization process for preparing a water soluble polymer. It is therefore alleged that it would have been obvious to one having ordinary skill in the art to perform the process of Kliment in water as taught by Kirk to eliminate the toxic solvent from the polymerization process.

Applicants respectfully traverse the rejection of claims 1-4, 8, 9, and 13-15. Kliment discloses that the disadvantages of previous suspension polymerization of hydroxyethyl methacrylate containing 0.05 to 0.1% of diester have now been overcome and a polymer which is completely soluble in dimethylformamide at 10% solids is obtained *if certain critical conditions are observed*. See Column 2, lines 1-8.

The first “critical condition” disclosed in Kliment is that the polymerization must be carried out in an organic solvent or diluent for the monomer. Kliment specifically discloses that solvent soluble solid hydrophilic polymers and copolymers of hydroxyethyl methacrylate are prepared by polymerizing the monomer in an organic solvent or diluent for the monomer. See Column 1, lines 13-16; Column 2, lines 7-10.

The specific examples reported in Kliment further support the criticality of the use of an organic solvent to carry out the polymerization process. The exemplary polymerization processes reported in Kliment utilize n-butanol (Example 2), n-butanol/benzyl alcohol (Example 6), ethyl acetate (Example 4),

heptane (Example 5), and toluene (Examples 3 and 7-17) as the polymerization solvents. Kliment does not disclose, suggest, or provide motivation to carry out the polymerization process in a solvent other than an organic solvent.

In contrast to Kliment, Kirk discloses an aqueous polymerization process. Kirk, however, does not disclose, suggest, or provide motivation for the use of any other polymerization solvent or co-solvent, such as water. Kliment clearly teaches away from using water as the polymerization solvent for hydroxyethyl methacrylate. While reducing the use of toxic solvents may be desirable, it is simply not proper to ignore the clear and unequivocal teachings regarding the criticality of the use of organic solvents found in Kliment. Therefore, there is simply no motivation to combine Kliment, which teaches the criticality of using organic solvents, with Kita, which requires water as the sole the polymerization solvent. Applicants therefore respectfully request that the rejection of claims 1-4, 8, 9, and 13-15 be withdrawn.

Claims 5-7, 10-12, 16-21, and 24-26 have been rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 3,784,540 to Kliment in view of U.S. Patent No. 5,601,723 to Kirk and in further view of JP 09241596 or JP 62227682.


Applicants respectfully traverse this rejection. While JP '596 and '682 disclose a pressure sensitive adhesive including polyethylene glycol, the combination of Kliment, Kirk and either JP '596 or JP '682 does not arrive at the presently claimed process for preparing a pressure sensitive adhesive. Kliment teaches that it is critical that the polymerization be carried out in an organic solvent. On the other hand, Kirk teaches away from Kliment by requiring polymerization in water. Thus, there is no motivation to combine the processes of Kliment and Kirk. The teachings of JP '596 and JP '682 to add polyethylene glycol to a polymer is irrelevant, in view of the fact that it is improper to combine Kliment and Kirk.

Claim 22 has been rejected under 35 U.S.C. 102(b) or in the alternative under 35 U.S.C. 103(a) over U.S. Patent No. 3,784,540 to Kliment. Applicants respectfully traverse the rejection of claim 22. Claim 22 recites a cosmetic composition containing the a powdered poly 2-hydroxyethyl methacrylate prepared by the process of claim 1. Kliment simply does not disclose, suggest, or provide motivation for a cosmetic composition containing the poly 2-hydroxyethyl methacrylate powder. As Kliment does not disclose each and every limitation of claim 22, Kliment does not anticipate claim 22 under 35 U.S.C. 102(b). As there is no teaching or suggestion in Kliment to incorporate the polymer powder into a cosmetic composition, Kliment does not render the claim 22 obvious. Applicants therefore respectfully request that this rejection be withdrawn.

Dependent claim 27 has been added to the present application. Applicants have previously paid for a total of 26 claims. Applicants have enclosed a check in the amount of \$50.00 for the cost of 1 additional dependent claim. A Patent Application Fee Determination Record form is also enclosed with the present response.

Should there be any questions regarding the above amendments or remarks, Applicants' undersigned attorney would welcome a telephone call.

Respectfully submitted,



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8-4-2005

Date